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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
10/524,007	02/08/2005	Stefan Koller	HM/15-22735/PCT	9480
324 7590 04/02/2008				
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EXAMINER				
HOLLOMAN, NANETTE				
ART UNIT		PAPER NUMBER		
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Please find below and/or attached an Office communication concerning this application or proceeding.

The time period for reply, if any, is set in the attached communication.

Office Action Summary

Application No.

10/524,007

Applicant(s)

KOLLER ET AL.

Examiner

NANNETTE HOLLOMAN

Art Unit

4131

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --
Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) OR THIRTY (30) DAYS, WHICHEVER IS LONGER, FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

- 1) ☐ Responsive to communication(s) filed on ____.
- 2a) ☐ This action is **FINAL**. 2b) ☒ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

- 4) ☒ Claim(s) 1-11 is/are pending in the application.
- 4a) Of the above claim(s) ____ is/are withdrawn from consideration.
- 5) ☐ Claim(s) ____ is/are allowed.
- 6) ☒ Claim(s) 1-11 is/are rejected.
- 7) ☒ Claim(s) 1 & 4-5 is/are objected to.
- 8) ☐ Claim(s) ____ are subject to restriction and/or election requirement.

Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on ____ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

Priority under 35 U.S.C. § 119

- 12) ☒ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☒ All b) ☐ Some * c) ☐ None of:
1. ☒ Certified copies of the priority documents have been received.
 2. ☐ Certified copies of the priority documents have been received in Application No. ____.
 3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

* See the attached detailed Office action for a list of the certified copies not received.

Attachment(s)

- 1) ☒ Notice of References Cited (PTO-892)
- 2) ☐ Notice of Draftsperson's Patent Drawing Review (PTO-948)
- 3) ☐ Information Disclosure Statement(s) (PTO/55/08)
Paper No(s)/Mail Date ____.
- 4) ☐ Interview Summary (PTO-413)
Paper No(s)/Mail Date ____.
- 5) ☐ Notice of Informal Patent Application
- 6) ☐ Other: ____.

DETAILED ACTION

Claims 1-11 are pending and are the subject of this Office Action. This is the first Office Action on the merits of the claims.

The Preliminary Amendment filed on February 8, 2005 to place the instant claims in better condition for examination on their merits has been received and entered.

Claim Objections

Claims 1 and 4-5 are objected to because of the following informalities: Claim 1 is objected to because it appears that "yielding" is misspelled as "yeilding."

Claim 4 is objected to for reciting an improper Markush group. The language "selected from the group consisting of wood, plastics, paper **or** textile material" should state "selected from the group consisting of wood, plastics, paper **and** textile material."

Claim 5 is objected to because the claim is a method according to "claim 5". It appears the claim should state "claim 4" and will be treated as such.

Appropriate correction is required.

Claim Rejections - 35 USC § 112

The following is a quotation of the second paragraph of 35 U.S.C. 112:

The specification shall conclude with one or more claims particularly pointing out and distinctly claiming the subject matter which the applicant regards as his invention.

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Claims 1-10 are rejected under 35 U.S.C. 112, second paragraph, as being indefinite for failing to particularly point out and distinctly claim the subject matter which applicant regards as the invention.

Claim 1 recites the limitation "the thus obtained water-soluble ester". In the text that comes before this phrase, there is no reference to "a water-soluble ester". There is insufficient antecedent basis for this limitation in the claim.

Claim 1 step (d) recites the limitation "the ester". It is unclear whether "the ester" refers to the halogen-substituted ester of step (a) or the water-soluble ester of step (c).

Claim Rejections - 35 USC § 102

The following is a quotation of the appropriate paragraphs of 35 U.S.C. 102 that form the basis for the rejections under this section made in this Office action:

A person shall be entitled to a patent unless –

(b) the invention was patented or described in a printed publication in this or a foreign country or in public use or on sale in this country, more than one year prior to the date of application for patent in the United States.

Claims 1-6 and 9-11 are rejected under 35 U.S.C. 102(b) as being anticipated by Struillou et al. (European Patent # 0752465 A1). Struillou et al. teaches a method for the controlled release of a biologically active hydroxyl group containing substance. Struillou et al. teaches the method of reacting an alcohol with a halogen-substituted aliphatic carboxylic acid halide, chloroacetyl chloride, forming a halogenoacetate ester and reacting said ester with a pyridine and substituted pyridine in particular 4-dimethylaminopyridine (as claimed by applicant). Chloroacetyl chloride is a known

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acetyl chloride (example 5, pg 28). Struillou et al. also teaches the solution of an alcohol/phenol, chloroacetyl chloride and pyridine (pg. 29, line 4).

Struillou et al. discloses this slow release concept may be applied to hard surfaces, textiles and cosmetics and that the releasable R-group of the compounds of the disclosed invention may be bactericides and/or biocides, such as m-chloroxylenol or triclosan (equivalent to Applicant's claimed "biologically active hydroxy group containing substance"; pg. 12, lines 57-59). Struillou et al. also discloses the ester bond is hydrolysed by atmospheric moisture after being deposited on a fabric (pg. 3, lines 34-36).

Claims 1, 4-7 and 11 are rejected under 35 U.S.C. 102(b) as being anticipated by Koller et al. (U.S. Patent #4083847). Koller et al. discloses a method for the controlled release of a biologically active hydroxyl group containing substance. Koller et al. teaches a method of reacting a dye that contains a hydroxy group with a halogen-substituted aliphatic carboxylic acid halide, chloroacetyl chloride, forming a halogenoacetate ester and reacting said chloroacetic ester molecule with a diamine (column 16, line 62 and column 24, lines 3-7). Chloroacetyl chloride is a known acetyl chloride. Koller et al. discloses a solution of a dye containing a hydroxy group, chloroacetyl chloride, and N, N, N', N-tetramethylethylenediamine (Example 4, column 27, lines 1-30). The N, N, N', N-tetramethylethylenediamine is the same compound as claimed (See the Material Safety Data Sheet, printed 02/05/2004, section 2-Composition/Information on Ingredient, Formula synonyms, compounds 1 and 6).

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Koller et al. also discloses applying the dye to the textile fiber followed by hydrolysis of the carbacyl group, which is the ester group (column 2, lines 23-24).

Conclusion

No claim is allowed.

Any inquiry concerning this communication or earlier communications from the examiner should be directed to NANNETTE HOLLOMAN whose telephone number is (571) 270-5231. The examiner can normally be reached on Mon-Fri 730am-500pm.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Janet Andres can be reached on 571-272-0867 or Cecilia Tsang on 571-272-0562. The fax phone number for the organization where this application or proceeding is assigned is 571-273-8300.

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free). If you would like assistance from a USPTO Customer Service Representative or access to the automated information system, call 800-786-9199 (IN USA OR CANADA) or 571-272-1000.

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/NANNETTE HOLLOMAN/

Examiner, Art Unit 4131

/Ardin Marschel/

Supervisory Patent Examiner, Art Unit 1614